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REMARKS

In the Final Office Action Examiner rejected claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47, and 49. Reconsideration of the application in view of the remarks set forth below is respectfully requested.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47, and 49 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection.

Legal Precedent and Guidelines

The Examiner's focus during examination of claims for compliance with the requirement for definiteness under 35 U.S.C. § 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. *See* M.P.E.P. § 2173.02. The applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. *See* M.P.E.P. §§ 2173.01 and 2173.05; *In re Swinehart*, 439 F.2d 10, 160 U.S.P.Q. 226, (C.C.P.A. 1971). The Examiner is also reminded not to equate breadth of a claim with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (C.C.P.A. 1971).

The essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. *See* M.P.E.P. § 2173.02. As set forth in Section 2173 of the Manual of Patent Examining Procedure, definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35

U.S.C. § 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000). Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must it be declared indefinite. *See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 U.S.P.Q.2d 1081, 1089 (Fed. Cir. 2004). Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *See Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 U.S.P.Q.2d 1996, 1999-2000 (Fed. Cir. 2004).

Deficiencies of Rejection

In the Office Action, the Examiner specifically stated:

a. In claim 1;

The added phrase "configured to operate independently of a central processing unit (CPU) of the managed computer system" adds too many ambiguities and confusion to the claimed invention as follows:

Firstly, it is unclear as to what is operating independently of the CPU of the managed computer system (i.e., remote computer system, remote console, managed computer system, board processor).

Secondly, how does the CPU of the managed computer system structurally and functionally inter-coupled to the managed computer system?

Thirdly, it appears that none of the claimed limitations (i.e., a managed computer system, an expansion slot, a bus, a remote console functionality logic structure, etc) have anything to do with the CPU of the managed computer system in the first place. In other words, none of the claimed limitations (i.e., before this amendment) had any dependency upon the CPU that was never a part of the system in terms performing any claimed function.

Fourthly, it is unclear as to whether the CPU is part of the claimed managed system in terms of providing any function, because the amended portions of the claims (lines 9-10) contradicts the before amended claims. For example, it appears that the processor of the board (a part of the managed computer) controls the logic, but the CPU of the managed computer (also a part of the managed computer) does not control the managed system. For the above reasons, the added limitations of lines 9-10 are not utilized by the claimed system, nor contribute any function to the claimed system. Furthermore, the amendment does not further limit the claimed invention in terms of operation and function. To make a point, it appears that the amended "CPU" is

not any different than a piece of unused wire or dust in the managed system; they both do not contribute any function to the claimed system.

For the above reasons, the examiner cannot determine the metes and bounds of the claimed invention, due to many different possible interpretations of the claimed invention.

The above unclarities are similarly applied to the rest of the amended claims.

b. In claim 5;

The added phrase "configured to operate notwithstanding whether a CPU of the managed computer system malfunctions" adds too many ambiguities and confusion to the claimed invention as follows:

Firstly, how does the CPU of the managed system structurally and functionally inter-coupled to the management computer system? What functions or operations do the CPU provides to the managed system when the CPU does not malfunction?

Secondly, from the context of the claim 5, it appears that none of the claimed limitations (i.e., a managed computer system, I/O processor, video controller, a bus, remote console functionality logic structure, etc) have anything to do with the CPU of the managed computer system in the first place. In other words, none of the claimed limitations (i.e., before this amendment) had any thing to do with the malfunctioning of the CPU.

Thirdly, it is unclear as to whether the CPU is part of the claimed managed system in terms of providing any function, because the amended portions of the claims (lines 9-10) contradicts the before amended claims. For example, it appears that the processor of the board (a part of the managed computer) controls the logic, but the CPU of the managed computer (also a part of the managed computer) does not control the managed system. For the above reasons, the added limitations of lines 5-6 are not utilized by the claimed system, nor contribute any function to the claimed system. Furthermore, the amendment does not further limit the claimed invention in terms of operation and function. To make a point, it appears that the amended "CPU" is not any different than a piece of unused wire or dust in the managed system; they both do not contribute any function to the claimed system; in addition, the claimed managed system properly operates even when the CPU malfunctions.

For the above reasons, the examiner cannot determine the metes and bounds of the claimed invention, due to many different possible interpretations of the claimed invention.

The above unclarities are similarly applied to the rest of the amended claims.

c. In claim 9;

The added phrase "with diverting resources from a system processor of the managed computer system" adds too many ambiguities and confusion to the claimed invention as follows:

Firstly, how does the system processor of the managed computer system structurally and functionally inter-coupled to the management computer system in terms of having any relationship with the resources? What functions or operations do the system processor provides to the managed system in terms of affecting resources of the system.

Secondly, from the context of the claim 9, it is unclear as to whether the system processor is connected to the bus. If not, the above limitations do not further limit the previous claimed invention; if so, the claimed limitation do not further limit from the claimed invention, since the amended claim 9 still do not provide any functional or structural relationship to support diverting or without diverting resource limitation.

Thirdly, similar to claims 1 and 5, the added "system processor" does not have anything to do with the claimed limitations (i.e., claim 9 does not provide any hint or explanation as to how the system processor is functionally or structurally interconnected to the bus); therefore, it is unclear as to how the added limitations is accomplished (i.e., the examiner has to rely on the common knowledge or guess what the applicant is trying to claim). In addition, the added limitation is not utilized by the claimed system.

To make a point, it appears that the amended "system processor" is not any different or further limiting than a piece of unused wire or dust in the managed system; they both do not contribute any function to the claimed system.

For the above reasons, the examiner cannot determine the metes and bounds of the claimed invention, due to many different possible interpretations of the claimed invention.

The above unclarities are similarly applied to the rest of the amended claims.

d. Claims 16, 23, 30, 33, 40 & 47;

As for the rest of the independent claims 16, 23, 30, 33, 40 & 47, the unclarities of the claims 1, 5 & 9 are similarly applied; the nature of the unclarities of the above independent claims are substantially identical.

The phrase "configured to operate independently of a central processing unit (CPU) of the managed computer system" in claim 1 is clearly supported by the specification and is unambiguous in view of the claim language. As for the Examiner's first concern, the *remote console functionality assist logic structure* is configured to operate independently of the CPU of the managed system; this is directly supported by the claim language. Moreover, the specification provides that the managed system of the present invention "is expandable by

virtue of a dedicated processor for controlling the remote console functionality assist logic," thus indicating that the logic structure recited in claim 1 is capable of operating independently of the CPU. Application, col. 10, lines 7-8. As for the Examiner's second concern, the remote console functionality assist logic structure and the CPU are both part of the managed system, but the logic structure functions independently of the CPU. As for the Examiner's third concern, prior to the amendment adding the CPU to claim 1, the logic structure as then presented could have been dependent upon the CPU. However, as currently presented, the logic structure is configured to function independently from the CPU. As for the Examiner's fourth concern, claim 1 provides that the *logic structure* is configured to operate independently of the CPU, *not* the system as a whole. As suggested by the Examiner, the processor of the board controls the logic structure. However, the CPU of the managed computer does in fact control the managed system as a whole. The processor is provided so that the CPU of the managed system does not have to control the logic structure.

Similarly, the phrase "configured to operate notwithstanding whether a CPU of the managed computer system malfunctions" in claim 5 is unambiguous in view of the claim language. As for the Examiner's first concern, the remote console functionality assist logic structure and the CPU are both part of the managed system, but the logic structure functions independently of the CPU. Since the CPU is only mentioned with respect to the logic structure, the functions or operations that the CPU provides to the managed system when the CPU does not malfunction is irrelevant. As for the Examiner's second concern, prior to the amendment adding the CPU to claim 5, the logic structure as then presented could have been dependent upon the CPU. However, as currently presented, the logic structure is configured to function independently from the CPU. As for the Examiner's third concern, claim 5 provides that the *logic structure* is configured to operate independently of the CPU, *not* the system as a whole. As suggested by the Examiner, the processor of the board controls the logic structure. However, the CPU of the managed computer does in fact control the managed system as a whole. The processor is provided so that the CPU of the managed system does not have to control the logic structure.

Furthermore, the phrase "without diverting resources from a system processor of the managed computer system" in claim 9 is unambiguous in view of the claim language. As for the Examiner's first concern, the remote server console device and the system processor are

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both part of the managed system, but the remote server console device functions independently of the system processor. Since the system processor is only mentioned with respect to the remote server console device, the functions or operations that the system processor provides to the managed system is irrelevant. As for the Examiner's second concern, it is irrelevant whether the system processor is connected to a bus, since the aim of including the system processor in claim 9 is to demonstrate that the remote server console device can function without it. As for the Examiner's third concern, prior to the amendment adding the system processor to claim 9, the remote server console device as then presented could have been dependent upon the system processor. However, as currently presented, the remote server console device is configured to function independently from the system processor.

Finally, the aforementioned propositions should sufficiently address any concerns the Examiner may have regarding independent claims 16, 23, 30, 33, 40, and 47. For at least these reasons among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Youngblood et al. (U.S. Pat. No. 5,062,059, hereinafter "Youngblood"). Applicants respectfully traverse this rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Additionally, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would

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have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Additionally, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Furthermore, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); see also *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111.

Initial Remarks

The present application relates to devices and techniques involved in remotely managing server computer systems. See Application, page 10, lines 5-13. In the field of remotely managed server computer systems, remote console functionality assist logic generally allows a user to access the server from a remote computer as if the user were at the server. See *id.*, page 6, lines 2-9. Remote console functionality assist logic provides remote access to a server in the event of a failure, when normal access to the server and internal diagnostic subsystems would remain otherwise inaccessible. See *id.*, page 5, line 13, to page 6, line 1. Remotely managing a server computer system using such logic thus *does not require the server computer system to be functioning properly* to gain remote access to the server; in fact, a particularly acute need for remote access arises *because of malfunction*. See *id.*, page 6, lines 16-23.

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The Youngblood reference stands in stark contrast, representing a system completely unrelated to remote server management. Instead, Youngblood discloses an apparatus for time-sharing a '386 computer, allowing multiple remote users on weaker computers to share the hardware resources of a single '386 system. See Youngblood, col. 1, lines 10-17; col. 2; lines 56-60. Where the instant application is directed to remotely managing and monitoring a host computer, the Youngblood reference teaches not remote management but total remote interconnection such that a remote terminal "appears to *physically reside in a memory unit* hardwired" to the host computer. *Id.*, col. 4, lines 46-47. (Emphasis added). Because the remote terminal of Youngblood serves merely as an extension of the host computer, if the host system malfunctions, the apparatus facilitating intercommunication would also cease to function. See *id.*, col. 5, line 64, to col. 7, line 33 (Youngblood apparatus receives commands from the host bus).

Claim Features of Independent Claims 1, 16, and 33 Omitted from Youngblood

In the instant application, independent claim 1 recites, *inter alia*, "an expansion slot; an expansion board comprising a processor... and a remote console functionality assist logic structure *controlled by the processor* to provide video signals generated by the managed computer system to a remote computer system and *configured to operate independently of a central processing unit (CPU) of the managed computer system.*" (Emphasis added). Independent claim 16 recites, "an add-in board disposed in the expansion slot, the add-in board comprising a processor" and "a remote console functionality assist logic structure *controlled by the processor and configured to operate independently of a central processing unit (CPU) of the computer system.*" (Emphasis added). Independent claim 33 recites, "an add-in board disposed in the expansion slot, the add-in board comprising a processor *configured to operate independently of a central processing unit (CPU) of the computer system*" and "remote server console device comprising a remote console functionality assist logic structure, wherein the operation of the remote server console device is *controlled by the processor.*" (Emphasis added).

In sharp contrast, Youngblood fails to disclose an expansion slot, expansion board or add-in board comprising a processor, remote console functionality assist logic *controlled by a processor*, or remote console functionality assist logic *configured to operate independently of*

a central processing unit (CPU) of the managed computer system. As discussed above, Youngblood relates to an apparatus for time-sharing a '386 computer system among multiple users on weaker remote terminal computers. See Youngblood, col. 1, lines 10-17; col. 2, lines 56-60. When in operation, the remote computer remains coupled to the host computer such that the remote terminal "appears to physically reside in a memory unit hardwired" to the host computer. *Id.*, col. 4, lines 46-47. (Emphasis added). As would be clearly appreciated by one of ordinary skill in the art, a memory unit hardwired to the host computer is ultimately controlled by the CPU of the host computer, and not by a processor contained on an expansion board.

The Examiner suggests that the host controller (1) and remote terminal (14) constitute remote functionality assist logic which is controlled by host logic controller (8). See Office Action, page 3, 1st paragraph. As FIG. 1 plainly indicates, however, a terminal logic controller (12) pertains to the remote terminal (14), while the host logic controller (8) pertains to the host controller (1). See Youngblood, FIG. 1. Accordingly, the host logic controller (8) could not reasonably be construed to control both the host controller (1) and the remote terminal (14) without completely ignoring the terminal logic controller (12). Even if, assuming *arguendo*, the host logic controller (8) of Youngblood were construed to be a processor, the host logic controller (8) merely facilitates communication between the host CPU (not pictured in FIG. 1) and the remote terminal via host controller (1), such that the host CPU recognizes the remote terminal as physically residing on the host bus (26). See *id.*, FIG. 1; col. 4, line 45, to col. 6, line 31. Furthermore, as evident in FIG. 4A, the host controller remains idle until receiving an initiation request from the host bus. See *id.*, FIG. 4A; col. 7, lines 9-33. In sum, the host logic controller (8) could not reasonably be construed to be a processor controlling remote functionality assist logic as presented in the instant claims.

Most critically, the apparatus of Youngblood relies on a CPU of the host computer to operate, and is plainly *not configured* to operate independently of a central processing unit (CPU) of the host. Youngblood is specifically directed to communication between a host CPU and a remote computer and clearly not to remote server management, as previously addressed. *Id.* As discussed above, the host controller and host logic controller (8) are controlled by the host CPU. See *id.*, FIG. 1; FIG. 4A; col. 7, lines 9-33; col. 4, lines 46-47.

The instant claims, however, recite logic *configured to operate independently of a central processing unit (CPU) of the managed computer system*. Because the apparatus of Youngblood is not configured to operate independently of a CPU of the host computer, and in fact, *could not operate without the host CPU*, Youngblood fails to disclose all elements of independent claims 1, 16 and 33. Accordingly, for at least this reason, Applicants respectfully request withdrawal of the rejection of independent claims 1, 16, and 33 under 35 U.S.C. § 103(a).

Claim Features of Independent Claims 5, 23, and 30 Omitted from Youngblood

Independent claim 5 recites, “a remote console functionality assist logic structure disposed on the bus and *configured to operate notwithstanding whether a central processing unit (CPU) of the managed computer system malfunctions*, the structure controlled by the processor.” (Emphasis added). Independent claim 23 recites, “a system processor operably coupled to an Input/Output (I/O) bus” and “a remote console functionality assist logic structure *disposed on the bus*, the logic structure adapted to capture the video signals of the video controller and direct video information to a remote computer system *notwithstanding whether a central processing unit (CPU) of the remotely managed computer system is functioning properly*.” (Emphases added). Independent claim 30 recites, “controlling a remote console functionality assist logic structure with an Input/Output processor, the remote console functionality assist logic structure being associated with the computer system and *configured to operate without regard to whether a central processing unit (CPU) of the computer system is malfunctioning*.” (Emphasis added).

As discussed above, Youngblood fails to disclose remote console functionality assist logic *controlled by a processor*. Additionally, however, Youngblood also fails to disclose remote console functionality assist logic *configured to operate notwithstanding whether a central processing unit (CPU) of the managed computer system malfunctions*. Since the apparatus of Youngblood relies on the CPU of the host computer to operate, as discussed above, the entire functionality of the apparatus of Youngblood therefore depends on the proper functioning of the host computer and the host CPU. See, e.g., Youngblood, FIG. 4A; col. 4, line 45, to col. 6, line 31; col. 7, lines 9-33. Youngblood, therefore, fails to disclose a device capable of operating when the host CPU malfunctions, and thus Youngblood fails to disclose all elements of independent claims 5, 23, and 30. Accordingly, for at least this

reason, Applicants respectfully request withdrawal of the rejection of independent claims 5, 23, and 30 under 35 U.S.C. § 103(a).

Claim Features of Independent Claim 9 Omitted from Youngblood

Independent claim 9 recites, “an expansion slot... an add-in board disposed in the expansion slot, the add-in board comprising an on-board processor” and “a remote server console device adapted to communicate on the bus *without diverting resources from a system processor of the managed computer system*, the device having a remote console functionality assist logic structure *controlled by the on-board processor*.” (Emphasis added).

As discussed above, Youngblood fails to disclose an expansion slot, an add-in board or expansion board, or remote console functionality assist logic *controlled by a processor*. Additionally, however, Youngblood also fails to disclose remote console functionality assist logic configured to operate *without diverting resources from a system processor of the managed computer system*. The apparatus of Youngblood relies on the CPU of the host computer to operate and, moreover, the communication logic of the apparatus of Youngblood is controlled by the host CPU. See Youngblood, FIG. 4A; col. 4, line 45, to col. 6, line 31; col. 7, lines 9-33. Because the host CPU must control and attend to the apparatus of Youngblood, as previously discussed, the apparatus of Youngblood diverts resources from the CPU of the host computer system. Youngblood, therefore, fails to disclose a device capable of operating without diverting resources from a system processor of the host computer, and thus fails to disclose all elements of independent claim 9. Accordingly, for at least this reason, Applicants respectfully request withdrawal of the rejection of independent claim 9 under 35 U.S.C. § 103(a).

Claim Features of Independent Claim 40 Omitted from Youngblood

Independent claim 40 recites, *inter alia*, “providing the computer system with a remote console functionality assist logic structure adapted to *monitor activities in the computer system* and provide data to a remote user; and providing a *processor* contained on an add-in board mounted in an expansion slot on a communication bus in the computer system to *control the remote console functionality assist logic*.” (Emphasis added).

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As discussed above, Youngblood fails to disclose an expansion slot, an add-in board or expansion board, or remote console functionality assist logic *controlled by a processor* contained on an add-in board mounted in an expansion slot. Additionally, however, Youngblood further fails to disclose remote console functionality assist logic structure adapted to *monitor activities in the computer system*. The apparatus of Youngblood relies on the CPU of the host computer to operate, and, moreover, the communication logic of the apparatus of Youngblood is controlled by the host CPU. *See* Youngblood, FIG. 4A; col. 7, lines 9-33. The host CPU must control and attend to the host controller (1) of Youngblood, as previously discussed. *See id.*; FIG. 1; col. 4, line 45, to col. 6, line 31. Youngblood does not disclose an apparatus adapted merely to *monitor activities* in the host computer, but rather discloses an apparatus adapted to completely join the remote and host computer in such a way that the remote terminal "appears to physically reside in a memory unit hardwired" to the host computer. *Id.*, col. 4, lines 46-47. Because, as discussed above, the device of Youngblood requires diverting the resources of the host CPU in order to function, the device of Youngblood is not capable of simply monitoring the activities of the host computer system. Youngblood, therefore, fails to disclose a device adapted to monitor activities in the computer system, and thus fails to disclose all elements of independent claim 40. Accordingly, for at least this reason, Applicants respectfully request withdrawal of the rejection of independent claim 40 under 35 U.S.C. § 103(a).

Claim Features of Independent Claim 47 Omitted from Youngblood

Independent claim 47 recites, "using a remote console functionality assist logic structure disposed on a bus and *controlled by an Input/Output processor configured to operate independently of a central processing unit (CPU) of the remotely managed computer system*." (Emphasis added).

As discussed above, Youngblood fails to disclose a remote console functionality assist logic structure *controlled by a processor configured to operate independently of a central processing unit (CPU) of the managed computer system*. Youngblood, therefore, fails to disclose all elements of independent claim 47. Accordingly, for at least this reason, Applicants respectfully request withdrawal of the rejection of independent claim 47 under 35 U.S.C. § 103(a).

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Improper Use of Official Notice

M.P.E.P. § 2144.03 provides that if applicants adequately traverse an assertion of Official Notice provided by the Examiner, the Examiner must provide documentary evidence supporting the assertion in the following Office Action in order to maintain the rejection. Moreover, § 2144.03 provides that if a traverse is inadequate, the Examiner should include an explanation as to why it is inadequate.

By admission of the Examiner, the Youngblood reference fails to disclose the add-in board or expansion slot as recited in the claims. In recognizing the deficiencies of Youngblood with respect to this element, the Examiner, in the Office Action mailed on December 4, 2006, took Official Notice of facts outside of the record that the Examiner apparently believed were capable of demonstration as being "well-known" in the art *prior to the priority date of the present application*. In accordance with M.P.E.P. § 2144.03, Applicants seasonably traversed the Examiner's use of Official Notice in their Response to the Office Action mailed on December 4, 2006. However, in the final Office Action, the Examiner simply reiterated the same Official Notice argument that he had previously presented in the December 4 Office Action. The Examiner failed to provide any evidence in response to this traverse. Moreover, the Examiner failed to include any explanation as to why the traverse was inadequate. Indeed, the Examiner failed to provide any indication that he had even considered Applicant's traverse. Thus, the Examiner failed to adhere to the M.P.E.P. § 2144.03 requirements regarding Official Notice. Accordingly, Applicants respectfully submit that the rejection based on Official Notice be withdrawn.

In view of the foregoing remarks, Applicants respectfully assert that the Youngblood reference, taken alone or in combination with the Official Notice, fails to disclose all the elements of the independent claims. As such, Applicants respectfully request withdrawal of the rejection of all independent claims, as well as all dependent claims based on their respective dependencies and for unique matter recited, and allowance of all pending claims.

Request for Withdrawal of Final Rejection

In making a final rejection, M.P.E.P. § 706.07 provides that an examiner should carefully review all outstanding grounds of rejection and should reiterate any such grounds on which he or she relies. The grounds of rejection "must also be clearly developed to such an

extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection." *Id.* Although a final rejection may refer to a statement of a ground of rejection in a previous Office Action, the final rejection "should include a rebuttal of any arguments raised in the applicant's reply." *Id.*

In the Office Action mailed on December 4, 2006, the Examiner rejected claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Youngblood. In the Response to the December 4 Office Action, Applicants addressed the § 103(a) rejection by adding recitations to independent claims 1, 5, 9, 16, 23, 30, 33, 40, and 47 along with accompanying arguments.

However, without addressing these recitations, the Examiner maintained the previously presented prior art rejection under 35 U.S.C. § 103(a) in the final Office Action. The maintenance of the Section 103(a) rejection was justified by the Examiner solely based on the newly presented definiteness rejection under Section 112, second paragraph. This justification was shortsighted, as M.P.E.P. § 2173.05(g) provides that whether a functional limitation complies with Section 112, second paragraph, is a different issue from whether such a limitation is distinguished over the prior art. That is to say, the Examiner was obliged to address each rejection independently, and he failed to so act. Hence, the Examiner failed to review all outstanding grounds of rejection carefully as required by M.P.E.P. § 706.07.

Furthermore, although the final Office Action reiterated the previously presented Section 103(a) rejection, the Examiner failed to address the arguments presented by Applicants regarding claim features that were omitted from Youngblood, and as previously discussed the Examiner failed to address Applicants' traverse of the use of Official Notice. In fact, the Examiner also failed to provide any indication that he had reviewed the previously presented Section 103(a) rejection in any reasonable manner. Instead, the Examiner simply restated the Section 103(a) rejection from the Office Action mailed on December 4, 2006. Thus, the Examiner failed to address arguments made by Applicants regarding this rejection as required by M.P.E.P. § 706.07.

In short, the final rejection was improper and premature on the part of the Examiner, as it directly contravened proper procedure as provided by the M.P.E.P. Accordingly,

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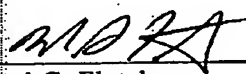
Applicants respectfully submit that the finality of the Examiner's Office Action be withdrawn.

Request for Interview

Applicants request that the Examiner along with his supervisor contact the undersigned at the telephone number listed below to schedule an interview to discuss the finality of the Examiner's Office Action. If the outcome of such an interview is not satisfactory, Applicants may be compelled to petition the Director under 37 C.F.R. § 1.181 based on the prematurity of the Examiner's final rejection as provided by M.P.E.P. § 1002.02(c).

Respectfully submitted,

Date: July 17, 2007



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